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| 10/085,514      | 02/28/2002  | Christoph Gurtler    | Mo6801/LeA 34,953   | 8714             |

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| EXAMINER |
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PUTTLITZ, KARL J

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| ART UNIT | PAPER NUMBER |
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1621

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/085,514

Applicant(s)

GURTLER ET AL.

Examiner

Karl J. Puttlitz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

The rejections under section 103 are maintained and repeated below.

Applicant's remarks in connection with this rejection are also addressed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-7, 11-17 and are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,580,947 to Brahm et al. (Brahm).**

The claims recite, *inter alia*:

A process for preparing a polyisocyanate containing acylurea groups which comprises reacting an isocyanate corresponding to formula (I) R--(NCO).sub.n (I), wherein R represents an n-valent linear or branched aliphatic group or cycloaliphatic group having 4 to 30 carbon atoms or an aromatic group having 6 to 24 carbon atoms and n is 1, 2, 3 or 4, with an aliphatic and/or aromatic carboxylic acid in the presence of a metal-salt catalyst at a temperature of 20 to 220°C. The claims also recite a product of this process and compositions. The rejected claims also recite specific arboxylic acid reagents.

In examples 1 to 3, Brahm teaches a process wherein "x equivalents of the isocyanate component ... and y equivalents of the dehydrated carboxylic acid component were added dropwise at 150°C within 3 to 4 hours." See column 6, lines 34-45.

Brahm teaches a catalysts at column 5, lines 9-16, e.g., "metal salts such as iron-(III) chloride or potassium octoate, tin compounds (such as tin-(II)-octoate, tin-(II)-ethylhexanoate, tin-(II)-laurate, aluminium-tri(ethylacetoacetate), dibutyl tin oxide, dibutyl tin dichloride, dibutyl tin diacetate, dibutyl tin dilaurate, dibutyl tin maleate or dioctyl tin diacetate) and mineral acids (such as sulphuric acid, hydrochloric acid, phosphoric acid and perchloric acid)." See column 5, lines 9-16.

Representative isocyanates: "Isocyanate component a) is selected from a1) isophorone diisocyanate or mixtures of isophorone diisocyanate with a2) other organic polyisocyanates which are present in quantities of up to 60% by weight, preferably up to 40% by weight and more preferably up to 30% by weight, based on the total weight of component a). . . . Starting isocyanates a2) have an isocyanate content of 10 to 60% by weight and include aliphatic and cycloaliphatic diisocyanates such as 1,4-diisocyanatobutane, 1,5-diisocyanatopentane, 1,6-diisocyanatohexane (HDI), dodecamethylene diisocyanate, undecane diisocyanate, 2,2,4-trimethylhexane diisocyanate, 1,3-cyclopentylene diisocyanate, cyclohexane-1, 3- and 1,4-diisocyanate, the isomeric diisocyanato dicyclohexylmethanes, 2,5- and 2,6-bis(isocyanatomethyl)bicyclo-[2.2.1]-heptane, isocyanatomethyl-1-

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methylcyclohexyl-isocyanate (IMCI), 1,4- and 1,3-di(isocyanatoisopropyl)-cyclohexane and xylene diisocyanate; diisocyanates containing aromatically bound isocyanate groups such as 2,4-diisocyanatotoluene and/or 2,6-diisocyanatotoluene, the isomeric diisocyanatodiphenylmethanes and higher homologues, 1,3-phenylene diisocyanate, 1,4-phenylene diisocyanate, 4,4'-biphenylene diisocyanate, 1,5-naphthylene diisocyanate, 1,4-naphthylene diisocyanate and 4,4'-diisocyanatodiphenylether; and mixtures of the preceding isocyanates... . Starting isocyanates a2) also include modification products of the above-mentioned diisocyanates containing biuret, uretdione, isocyanurate, allophanate and/or carbodiimide groups. Monofunctional isocyanates may also be used to obtain special properties, but are not preferred." See column 3, lines 13-42.

Representative carboxylic acids are "carboxylic acids having a molecular weight of 46 to 600, preferably 60 to 300. Both monobasic and polybasic carboxylic acids may be used. Examples include formic acid, acetic acid, the isomeric propanoic acids, butanoic acids, pentanoic acids, hexanoic acids, heptanoic acids, octanoic acids, nonanoic acids, decanoic acids, dodecanoic acids, tetradecanoic acids, hexadecanoic acids, octadecanoic acids, eicosanoic acids, docosanoic acids, tetracosanoic acids, dicarboxylic acids such as maleic acid, fumaric acid, malonic acid, adipic acid, sebacic acid, dimeric products of the unsaturated fatty acids b1), tricarboxylic acids [such as trimellitic acid, citric acid and trimeric products of the unsaturated fatty acids b1)], tetracarboxylic acids

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such as benzene tetracarboxylic acid, and mixtures of the preceding carboxylic acids." See column 4, lines 23-36.

Brahm also teaches compositions which can be used as binders. See column 6, lines 18-24.

The difference between Brahm and the rejected claims is that Brahm does not teach the invention recited in the rejected claims with sufficient particularity to amount to anticipation (See M.P.E.P. 2131: a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001).

Brahm teaches specific carboxylic acid reagents, for example, at column 4, lines 22-36, which includes dodecanoic acid.

However, Brahm does teach the elements of the claimed invention with a reasonable expectation of success. Therefore, one of ordinary skill would find the invention of the rejected claims *prima facie* obvious in view of Brahm.

With regard to product by process claim 11, the examiner notes that Brahm teaches the recited polyisocyanate. "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its

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method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) See M.P.E.P. § 2113.

Applicant argues that the examiner completely ignores the fact that the claimed carboxylic acids disclosed by Brahm are an optional minority component (up to 20%) and that Brahm specifically requires using olefinically unsaturated carboxylic acids (80-100 %). The present claims limit the carboxylic acid to embodiments where specific alkyl and aromatic carboxylic acids are used. The selected carboxylic acids effectively exclude the use of olefinically unsaturated carboxylic acids, which are required by Brahm.

However, notwithstanding the fact that Brahm requires the use of olefinically unsaturated carboxylic acids, Brahm still teaches and suggests the use of the claimed carboxylic acids, which is sufficient to support a rejection under section 103. In this regard, and in contrast to Applicant's assertions, the claims do not exclude the use of olefinically unsaturated carboxylic acids.

**Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent No. 3,970,600 to Falkenstein et al. (Falkenstein) in view of Brahm.**

Falkenstein teaches "a process for the production of stable, liquid solutions of isocyanurate-polyisocyanates containing amide and/or acylurea

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groups... wherein monomeric diisocyanates and/or polyisocyanates are modified with aliphatic and/or aromatic dicarboxylic acids ...[and] the resulting diisocyanates and/or polyisocyanates [contain] amide and/or acylurea groups"

See column 2, lines 32-47.

Example 3 features the process using phthalic acid. The examples also feature the use of adipic acid.

Representative isocyanates are: "aliphatic, cycloaliphatic, aliphatic-cycloaliphatic, araliphatic, cycloaliphatic-aliphaticaromatic and aromatic diisocyanates and/or polyisocyanates. In some cases it is desirable to add to the diisocyanates and/or polyisocyanates aliphatic, cycloaliphatic and/or aromatic monoisocyanates in amounts corresponding to from 0.01 to 0.5, preferably from 0.05 to 0.2 mole of monoisocyanate per mole of the diisocyanate and/or polyisocyanate in the isocyanate mixture. The diisocyanates and/or polyisocyanates containing amide and/or acylurea groups which have been produced in this way are of relatively low viscosity. Examples of suitable monoisocyanates are methylisocyanate, propylisocyanate, pentylisocyanate, cyclohexylisocyanate and phenylisocyanate. Examples of suitable diisocyanates are aliphatic diisocyanates, such as 1,6-hexamethylenediisocyanate, 1,10-decanediisocyanate and 1,12-dodecanediisocyanate, cycloaliphatic diisocyanates, such as 1,3- or 1,4-cyclohexanediisocyanate, 1-methylcyclohexane-2,4- and 2,6-diisocyanate and 3-isocyanatomethyl-3,5,5-trimethyl-cyclohexylisocyanate, araliphatic diisocyanates, such as cycloaliphatic-aliphatic-aromatic diisocyanates, e.g. 4-cyclohexyl-4'-



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phenylmethanediisocyanate, and aromatic diisocyanates, such as 1,3- and 1,4-phenylenediisocyanate, 2,4- and 2,6-toluylene-diisocyanate, naphthalene-1,5-diisocyanate and 2,4'-, 2,2'- and/or 4,4'-diphenylmethanediisocyanate. Examples of suitable polyisocyanates are 2,4,6-toluylenetriisocyanate, triphenylmethane-4,4',4''-triisocyanate and the polyphenyl-polymethylenepolyisocyanates obtained by condensation of aniline and/or halogen-substituted or alkyl-substituted anilines with formaldehyde, followed by phosgenation. The diisocyanates and/or polyisocyanates can be used individually or as mixtures. The use of the commercially available products 2,4- and 2,6-toluylenediisocyanates or of mixtures consisting of these isomers, 4,4'-, 2,4'- and/or 2,2'-diphenylmethane-diisocyanate and polyphenyl-polymethylene-polyisocyanates or mixtures of these isocyanates is preferred." See columns 3 and 4.

Finally, Falkenstein teaches the utility of the disclosed products in the manufacture of polyurethane coatings. Specifically, that "[t]he stable, liquid solutions according to the invention, which contain isocyanurate-polyisocyanates containing amide and/or acylurea groups can be used to manufacture polyurethanes. They are particularly suitable for the manufacture of polyurethane surface coatings, polyurethane adhesives and polyurethane foams of increased load-bearing capacity and improved flame-resistance.

The difference between the rejected claims and the disclosure of the Falkenstein is that the rejected claims additionally recite a metal-salt catalyst, and specific carboxylic acid. In this connection, Brahm teaches specific carboxylic

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acid reagents, for example, at column 4, lines 22-36, which includes dodecanoic acid.

In addition, Brahm teaches these catalysts in connection with reactions of isocyanates and carboxylic acids. In particular, Brahm teaches catalysts that are "metal salts such as iron-(III) chloride or potassium octoate, tin compounds (such as tin-(II)-octoate, tin-(II)-ethylhexanoate, tin-(II)-laurate, aluminium-tri(ethylacetoacetate), dibutyl tin oxide, dibutyl tin dichloride, dibutyl tin diacetate, dibutyl tin dilaurate, dibutyl tin maleate or dioctyl tin diacetate) and mineral acids (such as sulphuric acid, hydrochloric acid, phosphoric acid and perchloric acid)." See column 5, lines 9-16.

Furthermore Brahm teaches that by using these catalysts, the reaction may be accelerated. Accordingly, it would have been *prima facie* obvious to one of ordinary skill to modify the disclosure of Falkenstein by adding metal salt catalysts because Brahm teaches that using these catalysts will accelerate the reaction.

With regard to product by process claim 11, the examiner notes that the applied references teach the recited polyisocyanate. See M.P.E.P. § 2113 "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a

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different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Applicant argues that in order to arrive at the present invention, one skilled in the art would have to parse out the specifically claimed alkyl and aromatic carboxylic acids and then assume that a catalyst meant for unsaturated carboxylic acids would be effective with alkyl or aromatic carboxylic acids. There is no disclosure in Falkenstein or Brahm that would make such an assumption reasonable. Therefore, there is no motivation to combine references as the Examiner has.

However, Applicant still has not shown that those of ordinary skill would not be motivated to use the disclosed carboxylic acids in Falkenstein or Brahm. On the contrary, the combined references teach all of the elements of the claimed invention, including the claimed carboxylic acids, and therefore, Applicant has not overcome the prima facie case of obviousness based on their combination.

**Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,616,061 to Henning et al. (Henning) in view of Brahm.**

Henning teaches, *inter alia*, a process for the production of such solutions or dispersions by reacting (a) organic polyisocyanates, optionally in combination with the organic monoisocyanates with (b) isocyanate-reactive group-containing

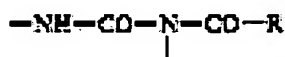
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compounds, optionally in the presence of (c) further auxiliaries and additives."

See column 2, lines 43-49.

Henning teaches the following isocyanate reagents: "Q(NCO)<sub>2</sub>, wherein Q represents an aliphatic hydrocarbon radical having 4 to 12 carbon atoms, a cycloaliphatic hydrocarbon radical having 6 to 15 carbon atoms, an aromatic hydrocarbon radical having 6 to 15 carbon atoms or an araliphatic hydrocarbon radical having 7 to 15 carbon atoms. The following are examples of such diisocyanates which are preferably used: tetramethylene diisocyanate, hexamethylene diisocyanate, dodecamethylene diisocyanate, 1,4-diisocyanatocyclohexane, 1-isocyanato-3,3,5-trimethyl-5-isocyanatomethylcyclohexane, 4,4'-diisocyanato-dicyclohexylmethane, 4,4'-diisocyanatodicyclohexylpropane-(2,2), 1,4-diisocyanatobenzene, 2,4-diisocyanatotoluene, 2,6-diisocyanatotoluene, 4,4'-diisocyanatodiphenylmethane, 4,4'-diisocyanatodiphenylpropane-(2,2), p-xylylene-diisocyanate or .alpha.,.alpha.,.alpha.,.alpha.-tetramethyl-m- or p-xylylenediisocyanate, and mixtures thereof."

In particular, Henning makes mention of isocyanates containing acylureas of the following formula:



See column 4, lines 4-11.

Representative carboxylic acids are: "acetic acid, propionic acid, *hexane carboxylic acid*, lauric acid, palmitic acid, stearic acid, benzoic acid, phenylacetic

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acid, acrylic acid, methacrylic acid, crotonic acid, 10-undecanoic acid, oleic acid or linoleic acid. It is also possible, in principle, to use other monocarboxylic acids in the process according to the present invention which do not correspond to the aforementioned definition of R such as chloroacetic acid, cyclohexane carboxylic acid, abietic acid, 4-dimethylaminobenzoic acid or monoesters or monoamides of dicarboxylic acids such as oxalic acid, malonic acid, succinic acid, maleic acid, fumaric acid or *phthalic acid* with monohydric alcohols or amines.” See column 5, lines 9-23 [emphasis applied].

The difference between the rejected claims and the disclosure of the Henning is that the rejected claims additionally recite a metal-salt catalyst. However, Brahm teaches these catalysts in connection with reactions of isocyanates and carboxylic acids. In particular, Brahm teaches catalysts that are “metal salts such as iron-(III) chloride or potassium octoate, tin compounds (such as tin-(II)-octoate, tin-(II)-ethylhexanoate, tin-(II)-laurate, aluminium-tri(ethylacetoacetate), dibutyl tin oxide, dibutyl tin dichloride, dibutyl tin diacetate, dibutyl tin dilaurate, dibutyl tin maleate or dioctyl tin diacetate) and mineral acids (such as sulphuric acid, hydrochloric acid, phosphoric acid and perchloric acid).” See column 5, lines 9-16.

Furthermore Brahm teaches that by using these catalysts, the reaction may be accelerated. Accordingly, it would have been *prima facie* obvious to one of ordinary skill to modify the disclosure of Henning by adding metal salt catalysts because Brahm teaches that using these catalysts will accelerate the reaction.

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With regard to product by process claim 11, the examiner notes that the applied references teach the recited polyisocyanate. See M.P.E.P. § 2113 "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Again, Applicant argues that in order to arrive at the present invention, one skilled in the art would have to parse out the specifically claimed alkyl and aromatic carboxylic acids and then assume that a catalyst meant for unsaturated carboxylic acids would be effective with alkyl or aromatic carboxylic acids. There is no disclosure in Henning or Brahm that would make such an assumption reasonable. Therefore, there is no motivation to combine references as the Examiner has.

However, Applicant still has not shown that those of ordinary skill would not be motivated to use the disclosed carboxylic acids in Henning or Brahm. On the contrary, the combined references teach all of the elements of the claimed invention, including the claimed carboxylic acids, and therefore, Applicant has not overcome the prima facie case of obviousness based on their combination.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday-Friday (alternate).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist.

Karl J. Puttlitz  
*Assistant Examiner*



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